

III. REMARKS

Claims 1-25 are pending in this application. Claims 1, 11, 14, and 20-25 have been amended, and no claims have been cancelled. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious allowance of the claimed subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 20-25 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

With regard to claim 20, the Office has interpreted a recordable medium to include an abstract idea that is not tied to a technological art, environment, or machine and as a result, indicated that this claim is not statutory. Applicant does not agree with such an interpretation in light of paragraphs 0009 and 0035 of the present patent application, which specifically note that the program product is a computer program product which when loaded in a computer system performs the functions recited in the claimed invention. Nevertheless, in order to expedite the prosecution of the present application, Applicant has amended claim 20 and its depending claims 21-25 to have the program product take the form of a computer-readable medium. Support for such a change is extracted from FIG. 1 and paragraphs 0009 and 0035, among others.

Although claims 20-25 now recite a computer-readable medium and not a program product, these claims still classify in the article of manufacture category of invention. Because claim 20 recites features similar to claim 1, such as identifying a user of the user interface; displaying an object within the user interface; and displaying a plurality of shortcuts for the

object..., Applicant submits that these features are independent physical acts that manipulate data representing physical objects to achieve a practical application and are not abstract.

Accordingly, Applicant submits that claim 20 and depending claims 21-25 are not abstract.

Because independent claims 1, 11, and 14 and their respective depending claims (i.e., claims 2-10, 12-13, and 15-19) fall within a statutory category enumerated in §101 and not within a judicially created exception, and recite a practical application, Applicant submits that the claimed invention recites statutory subject matter. In light of the above, Applicant believes that all grounds of the §101 rejection have been obviated. Therefore, Applicant requests that the Examiner reconsider and remove the §101 rejection.

In the Office Action, claims 1-4 and 6-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schacher, et al. (US Pat. No. 6,002,402, hereinafter, “Schacher”).

With respect to independent claim 1, Applicants have amended this claim herein (*see* lines 1 and 5), and respectfully submit that Schachter fails to teach each and every element of the invention of claim 1 as recited herein. Claim 1 recites “a method of automatically customizing a user interface,” the method comprising, in relevant part, “displaying a plurality of shortcuts for the object automatically adjusted based on the user and a history of object operations performed by the user to manage the object” (*id.*, emphasis indicating amendment). This amendment finds support in the specification at, e.g., [0005], lines 1-2, which recites, “automatically customizing a user interface based on a user, an object, and/or a history of object operations.”

Whereas the invention of claim 1 contemplates “automatically customizing a user interface,” as noted above, Schachter teaches “a simple choice-item drag-and-drop convert-to-object operation” (FIG. 3 and accompanying text *at* col. 7, lines 38-39). Schachter’s “drag-and-drop” method relies on steps including, *inter alia*, left-clicking on the HISTORY ... side menu;

moving the cursor to select a document, or choice item; right clicking on that choice item; holding the right mouse button down; dragging the icon 317b until it comes into a user-chosen, empty desktop region 312c, releasing the right mouse button; and dropping the dragged object 317b over new region 312c (col. 7, lines 52-67 (illustrated at FIG. 3)).

Schachter's teachings thus clearly fail to anticipate "automatically customizing a user interface," as they rely on user actions, such as holding a mouse button, dragging an icon, choosing an empty desktop region, etc. Schachter's teachings also fail to contemplate "displaying a plurality of shortcuts for the object automatically adjusted based on the user and a history of object operations performed by the user to manage the object," as recited in claim 1, lines 5-6. Schachter's customizing is not, in fact, "based on ... a history of object operations performed by the user" – it is entirely the product of a manual adjustment to the user interface, effected by a single manual action by a user.

Applicants further submit that Schachter does not teach the feature of "identifying a user of the user interface," taught in the invention of claim 1 at line 3. Applicants respectfully submit that although a user is recited as a passive participant in the passages cited by the Office (Office Action, p. 4, first bullet point (citing "column 6, lines 20-31, Figure 3, My File, column 7, lines user- preferences, column 14, lines 20-31")), Schachter does *not* teach the feature of "identifying a user of the user interface." Schachter merely alludes to the existence of a user, who may have internet/intranet web site "favorites" or "bookmarks," or may frequently send electronic mail to a given addressee (*see, e.g.*, cols. 6 and 14, lines 20-31 respectively). This user is implied by the possessive pronoun, "my" (FIG. 3, reference numeral 317b, entitled "MY_FILE2"). Such a presence of a user, however, does not constitute "identifying" that user, as recited in the invention of claim 1.

In view of at least the deficiencies discussed above, Applicants respectfully submit that Schachter fails to teach each and every feature of the invention of claim 1, and accordingly, fails to anticipate the same. For these reasons, Applicants respectfully request that the Office withdraw the rejection to claim 1 under § 102(b).

With respect to independent claims 11, 14, and 20, Applicants note that each of these claims have been amended analogously to claim 1 herein to include features similar in scope to those already addressed above with respect to claim 1. Further, the Office relies on the same arguments and interpretations of Schachter as discussed above with respect to claim 1. To this extent, Applicants herein incorporate the arguments presented above, and respectfully request the withdrawal of the rejections of independent claims 11, 14, and 20 for the above-stated reasons.

With respect to dependent claims 2-4, 6-10, 12-13, 15-19, and 21-25, Applicants respectfully submit that these claims are allowable for reasons stated above relative to independent claims 1, 11, 14, and 20, as well as for their own additional claimed subject matter. Accordingly, Applicants respectfully request that the Office withdraw the rejections under 35 U.S.C. § 102(b) to claims 2-4, 6-10, 12-13, 15-19, and 21-25.

In the Office Action, claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schacher in view of Roth et al. (US Pat. No. 6,266,060, hereinafter, "Roth"). Applicants respectfully submit that Roth fails to overcome the deficiencies in the Schacher reference discussed above. Further, Applicants submit that dependent claim 5 is allowable for reasons stated above relative to independent claim 1 and dependent claim 4, as well as for its own additional claimed subject matter. Accordingly, Applicants respectfully request that the Office withdraw the rejection under 35 U.S.C. § 103(a) to dependent claim 5.

IV. CONCLUSION

Applicants respectfully submit that the Application as presented is in condition for allowance. Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

/Meghan Q. Toner/
Meghan Q. Toner
Reg. No.: 52, 142

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(JMT)

Hoffman, Warnick and D'Alessandro, LLC
75 State Street, 14th Floor
Albany, New York 12207
Phone: (518) 449-0044
Fax: (518) 449-0047